

REMARKS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. The presently pending claims are 1 and 3-19.

In the Office Action, dated August 27, 2003, the Examiner stated that the Applicant's arguments in response to the Advisory Action have been considered but are moot in view of the new ground of rejection based on specification information related to DAB technology and newly cited reference Koen et al. (U.S. Patent No. 5,444,769).

The Examiner rejected claims 1, 3, 5-15, and 17-19 as being unpatentable under 35 U.S.C. 103(a) over Yoshinobu (U.S. Patent No. 5, 684, 526) further in view of Jonstromer (U.S. Patent No. 6,142,369) and Diehl et al. (U.S. Patent No. 5,173,589) and Suzuki (U.S. Patent No. 5,046,026) and Koen et al. (U.S. Patent No. 5,444,769). The Examiner's rejections are respectfully traversed.

As stated in previous responses, the claimed invention relates to a telecommunication method, as recited in claim 1, and a receiving apparatus for enabling the telecommunication method, as recited in claim 14. The receiving apparatus is an integrated telecommunications mobile device that comprises an identification card, a radio receiver and/or a television receiver, a reproducing means, as well as mobile radio components through which the telecommunications mobile device is operative in a mobile radio network. According to claims 1 and 14, the telecommunications mobile device is capable of receiving digital data as program-accompanying data transmitted with a media program, reproducing both the media program as well as the digital data on the telecommunications mobile device, preparing a message based on user-entered information, information from the digital

data, as well as user identification information from the identification card, and transmitting the message through a radio network.

Yoshinobu teaches a remote control transmitter (300, see column 5, lines 59 and 60, column 4, lines 49 and 50, and column 4, lines 53 and 54, see also Fig. 2 and Fig. 3) for transmitting a signal from the remote control transmitter to a transmitting apparatus (400, see Fig. 2 for the one-directional arrow between 300 and 400, column 6, lines 2-5, column 6, lines 6-8). The signal being transmitted is generated based on information manually entered by a user of the remote control transmitter who entered the information on the remote control transmitter based on a program (e.g. television program) displayed on a detached and separate television device and viewed by the user.

The remote control transmitter disclosed by Yoshinobu does not have a radio receiver and/or a television receiver enabling the remote control transmitter to receive digital data as program-accompanying data with a media program. Yoshinobu does not teach an identification card through which the user of the remote control transmitter may be automatically identified. In addition, Yoshinobu does not disclose, teach, or suggest a reproducing means reproducing a media program and displaying information of the received digital data. Furthermore, Yoshinobu does not teach a message preparing means capable of preparing a message, based on user entered command, and incorporating information from the received digital data and the user's identification.

The Examiner claims that it would have been obvious to one skilled in the art to modify Yoshinobu in a series of ways. The Office Action fails to set forth a prima facie case of obviousness because no motivation exists in the prior art itself to make the modifications required by the Examiner. For example, to derive the claimed

telecommunications mobile device, one has to take Yoshinobu's transmitting apparatus connected to the wired telephone line, making it wireless and combining it with a video phone. This suggested modification clearly conflicts with the motivation of Yoshinobu in that Yoshinobu's teaching is for a particular setting in which a television display device and a wired telephone line are already available and the Yoshinobu teaches how to utilize such existing resources to facilitate wired communications.

The Examiner asserts that it would have been obvious to one skilled in the art to further modify Yoshinobu by integrating a radio and/or television receiver into the video phone. Since the available television device in Yoshinobu has a television receiver and, as respectfully pointed out above, there can be no motivation for Yoshinobu to combine the existing television device, there is no motivation to integrate a television receiver into the hypothetical video phone. In addition, the particular setting to which Yoshinobu's disclosure is directed does not conduct radio communications (wired telephone communication), there is no motivation for Yoshinobu to suggest this further modification (to incorporate a radio receiver).

Suzuki also discloses a method in which a multicast broadcast receiver is used in combination with an ordinary television set and wired communications are performed through telephone lines. Similarly, Suzuki's teaching is for a particular setting, such as a home or office setting, in which a television set and a wired telephone line are already available. Suzuki differs from Yoshinobu in that Suzuki discloses a mobile device with a display, a radio receiver, and reproduction means to reproduce received audio signal. Since there is no motivation for Yoshinobu to have radio communication capability, Yoshinobu's teaching does not suggest that a radio receiver be combined.

The Examiner also asserts that it would have been obvious to one skilled in the art to combine Yoshinobu's one-way transmitter with the above modified device.

Yoshinobu does not teach a transmitter that is capable of both receiving and transmitting signals. Again, in the setting to which Yoshinobu's teaching is directed, television signals are received through the existing and separate television device. There is no need to have a modified transmitter that is capable of incorporating the functions of the existing television. Therefore, there can be no motivation for Yoshinobu to suggest such a modification.

The Examiner also asserts that it would have been obvious to one skilled in the art, in view of Jonstromer and Diehl, to further modify the combined Yoshinobu's transmitting apparatus, the hypothetical video phone, and the radio and/or television receiver by providing the combined hypothetical device an identification card. As indicated above, Yoshinobu discloses his invention for a specific setting. In this setting, there is no need or motivation to have an identification card because, if anything, the wired telephone is already capable of adequately identifying the source of the transmitted signal. There is no other additional reason for Yoshinobu to suggest to provide such an identification card to the modified device.

The Examiner also referenced Koen et al., which discloses a handheld terminal used in one way transmission. The handheld terminal, according to Koen et al., is connected to a station associated with an identification. It is not clear the purpose of this reference. Yoshinobu would not have suggested a mobile device connected to a station. Even if Yoshinobu motivates Koen's handheld terminal, the combination of Yoshinobu and Koen et al. would not have derived a mobile device as what is claimed in claim 14.

Since Yoshinobu does not have motivation to suggest any of the asserted modifications, the Examiner failed to present a prima facie case of obviousness. Therefore, it is not obvious to derive a telecommunications mobile **device**, over Yoshinobu in view of Jonstromer, Diehl, Suzuki, and Koen et al., as claimed in claim 14.

Furthermore, to accomplish the claimed telecommunication **method** based on Yoshinobu, one has to further, in addition to derive the modified Yoshinobu's device, one has to additionally enable the integrated radio and/or television receiver to **receive digital data** accompanying media data transmitted with a media program, facilitate **reproduction** of the received media data/digital data, and facilitate **preparing a message**, based on user's input, by incorporating information from the received digital data and the user's identification from the identification card.

None of the above features is present in Yoshinobu. In addition, Yoshinobu does not have any motivation, for the same reasons stated above, to suggest these claimed features. Therefore, it is not obvious to derive a telecommunications **method**, over Yoshinobu in view of Jonstromer, Diehl, Suzuki, and Koen et al., as claimed in claim 1.

The Examiner further cited statements from the specification that "DAB receivers containing a data decoder and a respective display are commercially available" (see last few sentence on page 1 of the specification). The Applicant respectfully points out that Digital Audio Broadcast (DAB) technology is related to radio systems only. The media program and its program-accompanying digital data recited in the claims 1 and 14 are not limited to radio signals. More importantly, the commercially available DAB technologies do not enable reproducing the media program and the digital data received as program-accompanying data. Particularly, the

available DAB technology does not enable automatically preparing a message that incorporates user-entered information, information from the digital data, and information related to user identification.

The combination of Yoshinobu, Jonstromer, Diehl et al., Suzuki, and Koen et al. fails to disclose, teach, or fairly suggest at least the features discussed above, as recited in claims 1 and 14. Therefore, Applicant respectfully requests that the rejection of claims 1 and 14 under 35 U.S.C. §103(a) be withdrawn.

Claims 3 and 5-13 depend from claim 1. Consequently, claims 3 and 5 -13 are patentable at least for the reasons stated above with respect to claim 1 and for the additional features recited therein. Therefore, Applicant respectfully requests that the rejection of claims 3 and 5 -13 under §103(a) be withdrawn.

Claims 15 and 17-19 depend from claim 14. Consequently, claims 15 and 17-19 are patentable at least for the reasons stated above with respect to claim 14 and for the additional features recited therein. Therefore, Applicant respectfully requests that the rejection of claims 15 and 17-19 under §103(a) be withdrawn.

The Examiner also rejected claims 4 and 16 under 35 U.S.C. 103(a) as being unpatentable over Yoshinobu and Jonstromer as applied to claims 14 or 15 above, and further in view of Alperovich et al. (U.S. Patent No. 6,138,002). The Examiner's rejection is respectfully traversed.

As discussed above, the combination of Yoshinobu and Jonstromer does not disclose, teach, or fairly suggest the features claimed in claims 1 and 14. Alperovich et al. does not remedy the deficiencies of Yoshinobu and Jonstromer. Alperovich et al. discloses a system that allows a mobile station (MS) or a SIM card within the MS to receive information from air interface to determine current time period, e.g., peak or off-peak, for a subscriber based on broadcast system date and time prior to

answering or placing a call on the mobile terminal. Although Alperovich et al. teaches the use of a Java script to be executed on the SIM card as recited in dependent claims 4 and 16, Alperovich et al. does not remedy the deficiencies of Yoshinobu and Jonstromer with respect to the features claimed in claim 1 and 14.

Claim 4 depends from claim 1. Consequently, claim 4 is patentable at least for the reasons stated above with respect to claim 1 and for the additional features recited therein. Therefore, Applicant respectfully requests that the rejection of claim 4 under §103(a) be withdrawn.

Claim 16 depends from claim 14. Consequently, claim 16 is patentable at least for the reasons stated above with respect to claim 14 and for the additional features recited therein. Therefore, Applicant respectfully requests that the rejection of claim 16 under §103(a) be withdrawn.

In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,
Pillsbury Winthrop, LLP

By: 

Dale S. Lazar

Reg. No.: 28872

Tel. No.: (703) 905-2126

Fax No.: (703) 905-2500

DSL\QCH:ml
P.O. Box 10500
McLean, VA 22102
(703) 905-2000